



Docket No.: 51410/P013US/09900130
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Peter Hartmaier

Application No.: 09/365,426

Confirmation No.: 1765

Filed: August 2, 1999

Art Unit: 3624

For: **SYSTEM AND METHOD FOR PREPAID
ACCOUNT REPLENISHMENT**

Examiner: D. S. Felten

SECOND APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Second Appeal Brief is filed in response to the Office Action mailed May 18, 2005 and in furtherance of the Notices of Appeal, filed in this case on May 19, 2004 and concurrently with this Second Appeal Brief. Appellant's Second Appeal Brief is timely filed within four months of the mailing date of the non-final Office Action mailed May 18, 2005, reopening prosecution.

Appellant respectfully notes that the Examiner has improperly reopened prosecution in the non-final Office Communication mailed May 18, 2005. 37 C.F.R. Part 41 (Practice Before the Board of Patent Appeals and Interferences) does not contain any provision for the Examiner to re-open prosecution in *ex parte* appeals in response to an appeal brief. The Examiner is limited to a response in the form of an Examiner's Answer in accordance with 37 C.F.R. § 41.39. The option to reopen prosecution is reserved for the Appellant if the Examiner's Answer includes a new ground of rejection. 37 C.F.R. § 1.193(b)(2) provided for a procedure whereupon prosecution can be reopened, and expressly delineated procedures for an Appellant to follow upon reopening of prosecution. However, this rule has been eliminated and replaced by 37 C.F.R. Part 41, effective September 13, 2004, which gives no such authority to the Examiner. Further supporting Appellants position is the fact that 37

Adjustment date: 09/21/2005 TBESHAH1
07/22/2004 AWONDAF1 00000012 09365426
01 FC:1402 -330.00 OP
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09/21/2005 TBESHAH1 00000023 062380 09365426
02 FC:1402 500.00 DA

C.F.R. Part 41 no longer has express guidance for the procedure to follow in response to an Examiner re-opening prosecution.

Appellant's attorney called the Office of Patent Legal Administration and spoke with Kery Fries, Senior Legal Advisor, on September 22, 2005. Mr. Fries indicated that the USPTO's position on 37 C.F.R. Part 41 is that Examiners retain the ability to reopen prosecution in response to a Notice of Appeal, and that the correct procedure to follow is to file a new Notice of Appeal and Appeal Brief. Mr. Fries also indicated that the previous fee paid for an earlier Notice of Appeal can be applied to the fees required for the new Notice of Appeal, and that the current fee schedule should be used. Appellant has thus relied on the guidance of Mr. Fries in filing this Second Appeal Brief.

Appellant's attorney unsuccessfully attempted to discuss the issues outlined above as well as new issues raised by the Examiner in the May 18, 2005 Office Communication. Appellant's attorney and the Examiner agreed to schedule a Telephonic Interview for August 17, 2005 at 2:00 P.M., and Appellant's attorney faxed a proposed interview summary to the Examiner on August 12, 2005. On August 17, 2005, Appellant's attorney attempted to contact the Examiner at the agreed upon time. However, the Examiner was not present and Appellant's attorney left a voice message. Later that day, when a response from the Examiner was not forthcoming, Appellant's attorney left an additional message with the Examiner and a message with the Examiner's supervisor, Vincent Millin. Appellant's attorney left additional messages for both the Examiner and the Examiner's supervisor on August 18, 2005 and August 29, 2005. Appellant has yet to receive the courtesy of a verbal or written response from either individual and must accordingly file this Second Appeal Brief.

The fees required under § 1.17(f) and any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

One copy of this Second Appeal Brief is submitted in accordance with § 41.37. This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

- I. Real Party In Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument
- VIII. Claims
- IX. Evidence
- X. Related Proceedings

Appendix A Claims

The final page of this brief bears the attorney's signature.

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Openwave Systems Inc., a Delaware corporation, having its principal place of business in Redwood City, California.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 16 claims pending in the application, which are identified as claims 12-15, 23, 29-32, and 34-40.

B. Current Status of Claims

In the May 18, 2005 Office Action, the status of the claims is as follows:

1. Claims canceled: 1-11, 16-22, 24-28, and 33.
2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 12-15, 23, 29-32, and 34-40
4. Claims allowed: None
5. Claims rejected: 12-14, 23, 29-32, and 34-40
6. Claims objected to: None

C. ClaimsAppealed

The appealed claims are: claims 12-15, 23, 29-32, and 34-40.

IV. STATUS OF AMENDMENTS

Appellant filed an Amendment After Final Rejection on January 13, 2004. All claim earlier amendments were entered and reviewed by the Examiner in the May 18, 2005 Office Action. Accordingly, the claims enclosed herein as Appendix A incorporate the last amendments to claims 12-14 and 29-32 that were made in the After Final Amendment filed January 13, 2004.

V. SUMMARY OF CLAIMED SUBJECT MATTER

According to claim 12, the method of claim 29 wherein said communicating with said prepaid engine further comprises the step of:

sending a message indicating an amount to be added to a particular prepaid account (p. 11, line 20-p. 12, line 7).

According to claim 13, the method of claim 29 wherein said bank is a banking institution (p. 9, lines 5-6).

According to claim 14, the method of claim 29 wherein said bank is an entity that supports financial transactions over a point of sale network (p. 9, lines 5-6).

According to claim 15, a method of providing prepaid account replenishment services comprising the steps of:

receiving real time data from a bank, wherein said data comprises information related to a replenishment transaction (p. 15, lines 11-23);

identifying a prepaid account number from said data (p. 15, lines 11-23);

sending an update message to a prepaid engine, wherein said update message comprises information regarding an amount of money to be added to said prepaid account (p.15, line 24-p.16, line 10);

receiving summary data from said bank, wherein said summary data comprises information related to a plurality of replenishment transactions (p. 16, lines 3-10);

reconciling individual replenishment transactions by comparing said real time data with said summary data (p. 16, lines 3-10); and

sending a disbursement message to said bank, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions (p. 16, lines 8-10).

According to claim 23, a method for replenishing prepaid accounts comprising the steps of:

receiving, at a voice response unit, calls from users desiring to replenish said prepaid accounts (p. 19, lines 24-25);

identifying each of said users (p. 19, lines 24-27; p. 20, lines 8-10);

prompting said users to select replenishment amounts (p. 19, lines 24-27);

processing replenishment transactions by causing the transfer of said replenishment amounts from a designated source account to said prepaid accounts (p. 20, lines 14-16);

prompting said users for a wireless telephone number (p. 20, lines 8-10); and

prompting said users for a personal identification number (p. 20, lines 10-11).

According to claim 29, a method of providing prepaid account services to consumers comprising the steps of:

assigning prepaid accounts to said consumers (p. 9, line 26-p. 10, line 6);

associating said prepaid accounts with wireless telephones (p. 9, line 26-p. 10, line 6);

communicating with a banking network regarding consumer replenishment transactions (p. 11, line 5), wherein said communicating with said banking network step further comprises the steps of:

receiving transaction messages following individual replenishment transactions by said consumers (p. 11, line 20-p. 12, line 7), wherein said receiving transaction messages step further comprises:

verifying location identification information associated with received transaction messages, wherein said location identification information identifies authorized replenishment locations (p. 12, lines 20-25);

receiving a reconciliation message summarizing substantially all individual transactions that occurred during a certain period (p. 13, lines 9-15);

reconciling said individual transactions (p. 13, lines 9-15); and

sending a message indicating the disbursement of funds associated with said replenishment transactions (p. 12, line 20-p. 13, line 8);

communicating with a prepaid engine regarding said consumer replenishment transactions (p. 12, line 20-p. 13, line 8); and

sending a disbursement message to said banking network, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions (p. 13, lines 16-23).

According to claim 30, a method of providing prepaid account services to consumers comprising the steps of:

assigning prepaid accounts to said consumers (p. 9, line 26-p. 10, line 6);

associating said prepaid accounts with wireless telephones (p. 9, line 26-p. 10, line 6);

communicating with a banking network regarding consumer replenishment transactions (p. 11, line 5), wherein said communicating with said banking network step further comprises the steps of:

receiving transaction messages following individual replenishment transactions by said consumers (p. 11, line 20-p. 12, line 7), wherein said receiving transaction messages step further comprises:

verifying that permanent account numbers have been activated (p. 12, lines 20-25);

receiving a reconciliation message summarizing substantially all individual transactions that occurred during a certain period (p. 13, lines 9-15); reconciling said individual transactions (p. 13, lines 9-15); and sending a message indicating the disbursement of funds associated with said replenishment transactions (p. 12, line 20-p. 13, line 8); communicating with a prepaid engine regarding said consumer replenishment transactions (p. 12, line 20-p. 13, line 8); and sending a disbursement message to said banking network, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions (p. 13, lines 16-23).

According to claim 31, a method of providing prepaid account services to consumers comprising the steps of:

assigning prepaid accounts to said consumers (p. 9, line 26-p. 10, line 6); associating said prepaid accounts with wireless telephones (p. 9, line 26-p. 10, line 6); communicating with a banking network regarding consumer replenishment transactions (p. 11, line 5), wherein said communicating with said banking network step further comprises the steps of:

receiving transaction messages following individual replenishment transactions by said consumers (p. 11, line 20-p. 12, line 7), wherein said receiving transaction messages step further comprises:

verifying that transaction identifiers associated with received transaction messages are not duplicates (p. 12, lines 20-25);

receiving a reconciliation message summarizing substantially all individual transactions that occurred during a certain period (p. 13, lines 9-15);

reconciling said individual transactions (p. 13, lines 9-15); and

sending a message indicating the disbursement of funds associated with said replenishment transactions (p. 12, line 20-p. 13, line 8);

communicating with a prepaid engine regarding said consumer replenishment transactions (p. 12, line 20-p. 13, line 8); and

sending a disbursement message to said banking network, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions (p. 13, lines 16-23).

According to claim 32, a method of providing prepaid account services to consumers comprising the steps of:

assigning prepaid accounts to said consumers (p. 9, line 26-p. 10, line 6);
associating said prepaid accounts with wireless telephones (p. 9, line 26-p. 10, line 6);
communicating with a banking network regarding consumer replenishment transactions (p. 11, line 5), wherein said communicating with said banking network step further comprises the steps of:

receiving transaction messages following individual replenishment transactions by said consumers (p. 11, line 20-p. 12, line 7), wherein said receiving transaction messages step further comprises:

identifying transaction messages that are in variance with information contained in said reconciliation message (p. 13, lines 9-15); and

logging said identified transaction messages in an exception file (p. 13, lines 9-15);

receiving a reconciliation message summarizing substantially all individual transactions that occurred during a certain period (p. 13, lines 9-15);

reconciling said individual transactions (p. 13, lines 9-15); and

sending a message indicating the disbursement of funds associated with said replenishment transactions (p. 12, line 20-p. 13, line 8);

communicating with a prepaid engine regarding said consumer replenishment transactions (p. 12, line 20-p. 13, line 8); and

sending a disbursement message to said banking network, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions (p. 13, lines 16-23).

According to claim 34, a system for replenishing prepaid accounts wherein real-time data is received from a bank, said real-time data comprising information related to a replenishment transaction and said data identifying a prepaid account (p. 11, lines 20-25), wherein the system comprises:

means for sending a message to a prepaid engine from a replenishment system, wherein said update message comprises information regarding an amount of money to be added to said prepaid account (p. 12, line 26-p. 13, line 8);

means for receiving summary data from said bank, wherein said summary data comprises information related to a plurality of said replenishment transactions (p. 13, lines 9-15);

means for reconciling individual replenishment transactions by comparing said real time data with said summary data (p. 13, lines 9-15); and

means for sending a disbursement message to said bank, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions (p. 13, lines 16-23).

According to claim 35, the system of claim 34 wherein said bank is a banking institution (p. 9, lines 5-6).

According to claim 36, the system of claim 34 wherein said bank is an entity that supports financial transactions over a point of sale network (p. 9, lines 5-6).

According to claim 37, the system of claim 34 further comprising:

means for verifying location identification information associated with real time data from said bank, wherein said location identification information identifies authorized replenishment locations (p. 13, lines 20-25).

According to claim 38, the system of claim 34 further comprising:

means for verifying that permanent account numbers have been activated (p. 20, lines 20-25).

According to claim 39, the system of claim 34 further comprising:

means for verifying that transaction identifiers associated with real time data from said bank are not duplicates (p. 20, lines 20-25).

According to claim 40, the system of claim 34 further comprising:

means for identifying replenishment transactions that are in variance with information contained in said summary data (p. 13, lines 9-15); and

means for logging replenishment transactions identified by said means for identifying into an exception file (p. 13, lines 9-15).

VI. ARGUMENT**A. First Ground of Rejection**

Claims 12-14 and 29-34 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

B. Second Ground of Rejection

Claims 12-14, 23, 29-32, and 34-40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Taskett* (WO 98/25237, hereinafter *Taskett* '237), in view of *Taskett* (WO 97/04579, hereinafter *Taskett* '579), further in view of *Hanson* (WO 98/34393).

C. Third Ground of Rejection

Appellant notes that claim 15 is pending in the application. However, while the Examiner has withdrawn the indicated allowability of claim 15 (See Office Action, page 2), the Examiner has failed to reject claim 15 and has failed to provide any rationale for rejection in the Office Action.

VII. ARGUMENT**A. First Ground of Rejection**

In the Office Action mailed May 18, 2005 reopening prosecution (hereinafter "Office Action"), the Examiner rejected claims 12-14 and 29-34 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner states that one of ordinary skill in the art would not understand from the specification the metes and bounds of the recited word "substantially." Appellant traverses the rejection and asserts that the claims are allowable.

Terms of degree do not automatically render a claim indefinite under 35 U.S.C. § 112, second paragraph. *See Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984). There are many examples of allowable claims reciting "substantially" as a claim limitation. *See, e.g., In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960) ("substantially increase" held definite); *In re Mattison*, 509 F.2d 563, 184 USPQ 484 (CCPA 1875) ("substantially equal" held definite). The term "substantially" is used in many technical and professional writings where those of skill in the art are assumed

to know what it delineates. *See, e.g.*, 37 C.F.R. § 41.37(c)(1) under heading “Appeal Brief” (“an appellant who is not represented by a registered practitioner need only *substantially comply* with paragraphs (c)(1)(i) through (c)(1)(iv)...”)(emphasis added).

Here, claims 12-14 and 29-34 recite “substantially all”. Appellant respectfully asserts that one of ordinary skill in the art would understand what is claimed by “substantially all” in light of the specification, and requests that the rejection of these claims be withdrawn.

B. Second Ground of Rejection

In the Office Action, claims 12-14, 23, 29-32, and 34-40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Taskett '237*, in view of *Taskett '579*, further in view of *Hanson*. Appellant traverses the rejection of these claims for the reasons provided below, and requests that the rejection be withdrawn and the claims passed to issue.

1. Cited References Fail to Teach or Suggest All Claim Limitations

To establish a *prima facie* case of obviousness, all claim limitations must be taught or suggested by the prior art. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Appellant respectfully asserts that *Taskett '237*, in view of *Taskett '579*, further in view of *Hanson* does not teach or suggest each and every element of the following claims.

a. Independent Claims

Claim 15

Claim 15 requires “sending a disbursement message to said bank, wherein said disbursement message comprises information regarding the distribution of funds associated with said replacement transactions.” *Taskett '237* teaches a host computer that retrieves information relating to a transaction instrument the transfers funds to a telephone card. *See Taskett '237* at page 15, lines 1-9. *Taskett '237* does not teach or suggest at least sending a disbursement message to a bank. Accordingly, *Taskett '237* does not teach or suggest at least the above-recited limitation of claim 15. The Examiner previously admitted that *Taskett '237* “also fails to disclose sending a disbursement message to the banking network, wherein the disbursement message network [sic] regarding the distribution of funds associated with the replenishment transactions.” *See* November 19, 2003 Office Action at page 4.

Taskett '579 teaches methods and apparatus for generating and transmitting summary transaction data. *See Taskett* '579 at page 3, lines 21-25. *Taskett* '579 does not teach or suggest sending a disbursement message to a bank. Accordingly, *Taskett* '579 does not teach or suggest at least the above-recited limitation of claim 15.

Hanson teaches replenishing a prepay wireless account using "cash, bank drafts, credit cards, and telephone company billing." *See Hanson* at page 8, lines 5-23. *Hanson* does not teach or suggest sending a disbursement message to a bank. Accordingly, *Hanson* does not teach or suggest at least the above-recited limitation of claim 15. Thus, *Taskett* '237, in view of *Taskett* '579, further in view of *Hanson* does not teach or suggest all limitations of claim 15. Appellant asserts that the 35 U.S.C. § 103(a) rejection of claim 15 is not proper.

Claim 23

Claim 23 requires "processing replenishment transactions by causing the transfer of said replenishment amounts from a designated source account to said prepaid accounts." The Examiner admits in the Office Action that *Taskett* '237 fails to disclose "processing replenishment transactions." *See* Office Action at page 7. Accordingly, *Taskett* '237 does not teach or suggest at least the above-recited limitation of claim 23. *Hanson* teaches replenishing a prepay wireless account using "cash, bank drafts, credit cards, and telephone company billing." *See Hanson* at page 8, lines 5-23. However, *Hanson* does not teach transferring replenishment amounts from a designated source account. Accordingly, *Hanson* does not teach or suggest at least the above-recited limitation of claim 23. *Taskett* '579 is not relied upon as curing the deficiencies of *Taskett* '237 or *Hanson* with respect to claim 23, and *Taskett* '579 does not teach/suggest element. Thus, *Taskett* '237, in view of *Taskett* '579, further in view of *Hanson* does not teach or suggest all limitations of claim 23. Therefore, the 35 U.S.C. § 103(a) rejection of claim 23 is not proper.

Claim 29

Claim 29 requires "verifying location identification information associated with received transaction messages, wherein said location identification information identifies authorized replenishment locations." The Examiner admits in the Office Action that *Taskett* '237 fails to disclose this limitation of claim 29. *See* Office Action, page 7. Accordingly,

Taskett '237 does not teach or suggest all limitations of claim 29. The Examiner states that *Hanson* teaches this limitation of claim 29. *Hanson* teaches the use of "authorized sales agents 64, retail outlets 66, and replenishing locations 68." *See Hanson* at page 6, lines 22-30. *Hanson* does not teach location identification information that identifies authorized replenishment locations. Accordingly, *Hanson* does not teach or suggest at least the above-recited limitation of claim 29. *Taskett* '579 is not relied upon as curing the deficiencies of *Taskett* '237 or *Hanson* with respect to claim 29 and does not teach/suggest the missing elements.

Claim 29 also requires "sending a disbursement message to said bank, wherein said disbursement message comprises information regarding the distribution of funds associated with said replacement transactions." *Taskett* '237 teaches a host computer that retrieves information relating to a transaction instrument the transfers funds to a telephone card. *See Taskett* '237 at page 15, lines 1-9. *Taskett* '237 does not teach or suggest at least sending a disbursement message to a bank. Accordingly, *Taskett* '237 does not teach or suggest at least the above-recited limitation of claim 29. The Examiner previously admitted that *Taskett* '237 "also fails to disclose sending a disbursement message to the banking network, wherein the disbursement message network [sic] regarding the distribution of funds associated with the replenishment transactions." *See* November 19, 2003 Office Action at page 4.

Taskett '579 teaches methods and apparatus for generating and transmitting summary transaction data. *See Taskett* '579 at page 3, lines 21-25. *Taskett* '579 does not teach or suggest sending a disbursement message to a bank. Accordingly, *Taskett* '579 does not teach or suggest at least the above-recited limitation of claim 29.

Hanson teaches replenishing a prepay wireless account using "cash, bank drafts, credit cards, and telephone company billing." *See Hanson* at page 8, lines 5-23. *Hanson* does not teach or suggest sending a disbursement message to a bank. Accordingly, *Hanson* does not teach or suggest at least the above-recited limitation of claim 29.

In view of the above, Appellant respectfully asserts that *Taskett* '237, in view of *Taskett* '579, further in view of *Hanson* does not teach or suggest all limitations of claim 29. Appellant asserts that the 35 U.S.C. § 103(a) rejection of claim 29 is not proper.

Claim 30

Claim 30 requires “verifying that permanent account numbers have been activated.” The Examiner admits that *Taskett* ‘237 fails to disclose this limitation of claim 30. *See* Office Action at page 7. The Examiner fails to show that either *Taskett* ‘579 or *Hanson* cure the deficiency of *Taskett* ‘237 with respect to this limitation of claim 30. Regardless, Appellant respectfully asserts that neither *Taskett* ‘579 nor *Hanson* teach or suggest the above-recited limitation of claim 30. *Taskett* ‘579 teaches methods and apparatus for generating and transmitting summary transaction data. *See* *Taskett* ‘579 at page 3, lines 21-25. *Taskett* ‘579 does not teach or suggest verifying that permanent account numbers have been activated. Accordingly, *Taskett* ‘579 does not teach or suggest at least the above-recited limitation of claim 30. *Hanson* teaches replenishing a prepay wireless account. *See* *Hanson* at page 8, lines 5-23. *Hanson* does not teach or suggest verifying that permanent account numbers have been activated. Accordingly, *Hanson* does not teach or suggest at least the above-recited limitation of claim 30.

Claim 30 also requires “sending a disbursement message to said bank, wherein said disbursement message comprises information regarding the distribution of funds associated with said replacement transactions.” *Taskett* ‘237 teaches a host computer that retrieves information relating to a transaction instrument the transfers funds to a telephone card. *See* *Taskett* ‘237 at page 15, lines 1-9. *Taskett* ‘237 does not teach or suggest at least sending a disbursement message to a bank. Accordingly, *Taskett* ‘237 does not teach or suggest at least the above-recited limitation of claim 30. The Examiner has previously admitted that *Taskett* ‘237 “also fails to disclose sending a disbursement message to the banking network, wherein the disbursement message network [sic] regarding the distribution of funds associated with the replenishment transactions.” *See* November 19, 2003 Office Action at page 4.

Taskett ‘579 teaches methods and apparatus for generating and transmitting summary transaction data. *See* *Taskett* ‘579 at page 3, lines 21-25. *Taskett* ‘579 does not teach or suggest sending a disbursement message to a bank. Accordingly, *Taskett* ‘579 does not teach or suggest at least the above-recited limitation of claim 30.

Hanson teaches replenishing a prepay wireless account using “cash, bank drafts, credit cards, and telephone company billing.” *See* *Hanson* at page 8, lines 5-23. *Hanson*

does not teach or suggest sending a disbursement message to a bank. Accordingly, *Hanson* does not teach or suggest at least the above-recited limitation of claim 30.

In view of the above, Appellant respectfully asserts that *Taskett* '237, in view of *Taskett* '579, further in view of *Hanson* does not teach or suggest all limitations of claim 30. Appellant asserts that the 35 U.S.C. § 103(a) rejection of claim 30 is not proper.

Claim 31

Claim 31 requires “verifying that transaction identifiers associated with received transaction messages are not duplicates.” The Examiner does not indicate that *Taskett* '237, *Taskett* '579, and/or *Hanson* teach or suggest this limitation of claim 31. Appellant respectfully asserts that none of the references teach or suggest the recited limitation of claim 31.

The Examiner states that “[i]t is conventional in banking systems and other networking system [sic] that verification in the system to detect against [sic] transaction duplication that would be made if someone was going [sic] make a fraudulent or erroneous transaction.” *See* Office Action at page 7. The Examiner then takes Official Notice of “transaction identifiers used for the purpose of determining if the transaction messages are not duplicates.” *See id.* Appellant respectfully traverses the Examiner’s Official Notice as improper, and respectfully asserts that the Examiner’s Official Notice fails to teach or suggest the above-recited limitation of claim 31. Claim 31 is directed to verifying that *transaction identifiers* are not duplicates; not determining if *transaction messages* are not duplicates. Accordingly, the Examiner’s Office Notice fails to teach or suggest the above-recited limitation of claim 31.

Additionally, the Examiner’s Official Notice fails to meet the recognized standard for such actions. Official Notice of facts beyond the record must be “capable of such instant and unquestionable demonstration as to defy dispute.” *See In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970) (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). Here, the Examiner states that “determining if transaction messages are not duplicates” is worthy of Official Notice “because such a notoriously old and well known practice would be an obvious extension to the aforementioned prior art to Thus [sic] to [sic] employ transaction identifiers associated with received transaction messages are [sic] not

duplicates [sic]”. Appellant respectfully asserts that the Examiner’s statement does not constitute an explicit basis of reasoning for the Official Notice as required by precedent. *See In re Soli*, 317 F.2d 941, 945-46, 137 USPQ 797, 800 (CCPA 1963). Appellant requests that the Examiner provide an appropriate explicit basis for the Official Notice or withdraw the statement.

Claim 31 also requires “sending a disbursement message to said bank, wherein said disbursement message comprises information regarding the distribution of funds associated with said replacement transactions.” *Taskett* ‘237 teaches a host computer that retrieves information relating to a transaction instrument the transfers funds to a telephone card. *See Taskett* ‘237 at page 15, lines 1-9. *Taskett* ‘237 does not teach or suggest at least sending a disbursement message to a bank. Accordingly, *Taskett* ‘237 does not teach or suggest at least the above-recited limitation of claim 31. Reflecting this fact, the Examiner has previously admitted that *Taskett* ‘237 “also fails to disclose sending a disbursement message to the banking network, wherein the disbursement message network [sic] regarding the distribution of funds associated with the replenishment transactions.” *See* November 19, 2003 Office Action at page 4.

Taskett ‘579 teaches methods and apparatus for generating and transmitting summary transaction data. *See Taskett* ‘579 at page 3, lines 21-25. *Taskett* ‘579 does not teach or suggest sending a disbursement message to a bank. Accordingly, *Taskett* ‘579 does not teach or suggest at least the above-recited limitation of claim 31.

Hanson teaches replenishing a prepay wireless account using “cash, bank drafts, credit cards, and telephone company billing.” *See Hanson* at page 8, lines 5-23. *Hanson* does not teach or suggest sending a disbursement message to a bank. Accordingly, *Hanson* does not teach or suggest at least the above-recited limitation of claim 31.

In view of the above, Appellant respectfully asserts that *Taskett* ‘237, in view of *Taskett* ‘579, further in view of *Hanson* does not teach or suggest all limitations of claim 31. Appellant asserts that the 35 U.S.C. § 103(a) rejection of claim 31 is not proper.

Claim 32

Claim 32 requires “identifying transactions messages that are in variance with information contained in said reconciliation message.” The Examiner admits that *Taskett* ‘237 fails to disclose receiving a reconciliation message summarizing individual transaction that occurred during a certain period, and reconciling said individual transactions. *See* Office Action at page 4. Appellant respectfully asserts that *Taskett* ‘237 does not teach or suggest the above-recited limitation of claim 32.

Taskett ‘579 teaches generating summary transaction data. *See* *Taskett* ‘579 at page 4, lines 19-27. However, *Taskett* ‘579 does not teach identifying transaction messages that are in variance with information contained in a reconciliation message. Accordingly, *Taskett* ‘579 does not teach or suggest the above-recited limitation of claim 32.

Hanson teaches a log of customer information that is kept at customer interface facilities. *See* *Hanson* at page 6, lines 31-35. *Hanson* does not teach identifying transaction messages that are in variance with information contained in a reconciliation message. Accordingly, *Hanson* does not teach or suggest the above-recited limitation of claim 32.

Claim 32 also requires “sending a disbursement message to said bank, wherein said disbursement message comprises information regarding the distribution of funds associated with said replacement transactions.” *Taskett* ‘237 teaches a host computer that retrieves information relating to a transaction instrument the transfers funds to a telephone card. *See* *Taskett* ‘237 at page 15, lines 1-9. *Taskett* ‘237 does not teach or suggest at least sending a disbursement message to a bank. Accordingly, *Taskett* ‘237 does not teach or suggest at least the above-recited limitation of claim 32. Reflecting this fact, the Examiner has previously admitted that *Taskett* ‘237 “also fails to disclose sending a disbursement message to the banking network, wherein the disbursement message network [sic] regarding the distribution of funds associated with the replenishment transactions.” *See* November 19, 2003 Office Action at page 4.

Taskett ‘579 teaches methods and apparatus for generating and transmitting summary transaction data. *See* *Taskett* ‘579 at page 3, lines 21-25. *Taskett* ‘579 does not teach or suggest sending a disbursement message to a bank. Accordingly, *Taskett* ‘579 does not teach or suggest at least the above-recited limitation of claim 32.

Hanson teaches replenishing a prepay wireless account using “cash, bank drafts, credit cards, and telephone company billing.” *See Hanson* at page 8, lines 5-23. *Hanson* does not teach or suggest sending a disbursement message to a bank. Accordingly, *Hanson* does not teach or suggest at least the above-recited limitation of claim 32.

In view of the above, Appellant respectfully asserts that *Taskett* ‘237, in view of *Taskett* ‘579, further in view of *Hanson* does not teach or suggest all limitations of claim 32. Appellant asserts that the 35 U.S.C. § 103(a) rejection of claim 32 is not proper.

Claim 34

Claim 34 requires “means for sending a disbursement message to said bank, wherein said disbursement message comprises information regarding the distribution of funds associated with said replacement transactions.” *Taskett* ‘237 teaches a host computer that retrieves information relating to a transaction instrument the transfers funds to a telephone card. *See Taskett* ‘237 at page 15, lines 1-9. *Taskett* ‘237 does not teach or suggest at least sending a disbursement message to a bank. Accordingly, *Taskett* ‘237 does not teach or suggest at least the above-recited limitation of claim 34. Reflecting this fact, the Examiner has previously admitted that *Taskett* ‘237 “also fails to disclose sending a disbursement message to the banking network, wherein the disbursement message network [sic] regarding the distribution of funds associated with the replenishment transactions.” *See* November 19, 2003 Office Action at page 4.

Taskett ‘579 teaches methods and apparatus for generating and transmitting summary transaction data. *See Taskett* ‘579 at page 3, lines 21-25. *Taskett* ‘579 does not teach or suggest sending a disbursement message to a bank. Accordingly, *Taskett* ‘579 does not teach or suggest at least the above-recited limitation of claim 34.

Hanson teaches replenishing a prepay wireless account using “cash, bank drafts, credit cards, and telephone company billing....” *See Hanson* at page 8, lines 5-23. *Hanson* does not teach or suggest sending a disbursement message to a bank. Accordingly, *Hanson* does not teach or suggest at least the above-recited limitation of claim 34.

In view of the above, Appellant respectfully asserts that *Taskett* '237, in view of *Taskett* '579, further in view of *Hanson* does not teach or suggest all limitations of claim 34. Appellant asserts that the 35 U.S.C. § 103(a) rejection of claim 34 is not proper.

b. Dependent Claims

If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *See In re Fine*, 837 F.2d 1071, 5 USPQ.2d 1596 (Fed. Cir. 1988). Claims 12-14 and 35-40 depend directly from either claim 29 or claim 34. As shown above, claims 29 and 34 are nonobvious under 35 U.S.C. § 103. Accordingly, claims 12-14 and 35-50 are also nonobvious. Appellant respectfully traverses the 35 U.S.C. § 103(a) rejection of claims 12-14 and 35-40 and requests that the rejection of record be withdrawn.

C. Third Ground of Rejection

Appellant notes that claim 15 is pending in the application. However, while the Examiner has withdrawn the indicated allowability of claim 15 (*See* Office Action, page 2), the Examiner has failed to reject claim 15 and has failed to provide any rationale for rejection in the Office Action. Under 37 C.F.R. § 1.104(c), the Examiner must “cite the best references at his or her command” and “[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.” Appellant respectfully asserts that the Examiner has not met the requirements of 37 C.F.R. § 1.104(c), and requests that the indication of allowability for claim 15 be reinstated. Nonetheless, Appellant has responded in the “Second Ground of Rejection” as if the Examiner intended to reject claim 15 under 35 U.S.C. § 103.

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A include the amendments filed by Appellant on January 13, 2004.

IX. EVIDENCE

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the Examiner is being submitted.

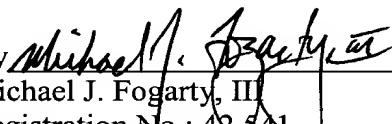
X. RELATED PROCEEDINGS

No related proceedings are referenced in Part II above, or copies of decisions in related proceedings are not provided. Hence, no Appending of Related Proceedings is included.

Appellant has included a Petition for a one-month extension and the accompanying fee. Also, Appellant requests that the Notice of Appeal fee of \$165.00 paid with the Notice of Appeal filed May 19, 2004 be applied to the increased \$500.00 appeal fee currently required and the Appeal Brief fee of \$330.00 paid with the Appeal Brief filed July 19, 2004 be applied toward the \$500.00 Appeal Brief fee currently required. A fee now due in the amount of \$625.00 is noted on the Fee Transmittal.

Dated: September 19, 2005

Respectfully submitted,

By 
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APPENDIX A**Claims Involved in the Appeal of Application Serial No. 09/365,426**

1-11. (Canceled)

12. (Previously Presented) The method of claim 29 wherein said communicating with said prepaid engine further comprises the step of:

 sending a message indicating an amount to be added to a particular prepaid account.

13. (Previously Presented) The method of claim 29 wherein said bank is a banking institution.

14. (Previously Presented) The method of claim 29 wherein said bank is an entity that supports financial transactions over a point of sale network.

15. (Original) A method of providing prepaid account replenishment services comprising the steps of:

 receiving real time data from a bank, wherein said data comprises information related to a replenishment transaction;

 identifying a prepaid account number from said data;

 sending an update message to a prepaid engine, wherein said update message comprises information regarding an amount of money to be added to said prepaid account;

 receiving summary data from said bank, wherein said summary data comprises information related to a plurality of replenishment transactions;

 reconciling individual replenishment transactions by comparing said real time data with said summary data; and

 sending a disbursement message to said bank, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions.

16-22. (Canceled)

23. (Previously Presented) A method for replenishing prepaid accounts comprising the steps of:

receiving, at a voice response unit, calls from users desiring to replenish said prepaid accounts;

identifying each of said users;

prompting said users to select replenishment amounts;

processing replenishment transactions by causing the transfer of said replenishment amounts from a designated source account to said prepaid accounts;

prompting said users for a wireless telephone number; and

prompting said users for a personal identification number.

24-28. (Canceled)

29. (Previously Presented) A method of providing prepaid account services to consumers comprising the steps of:

assigning prepaid accounts to said consumers;
associating said prepaid accounts with wireless telephones;
communicating with a banking network regarding consumer replenishment transactions, wherein said communicating with said banking network step further comprises the steps of:

receiving transaction messages following individual replenishment transactions by said consumers, wherein said receiving transaction messages step further comprises:

verifying location identification information associated with received transaction messages, wherein said location identification information identifies authorized replenishment locations;

receiving a reconciliation message summarizing substantially all individual transactions that occurred during a certain period;

reconciling said individual transactions; and

sending a message indicating the disbursement of funds associated with said replenishment transactions;

communicating with a prepaid engine regarding said consumer replenishment transactions; and

sending a disbursement message to said banking network, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions.

30. (Previously Presented) A method of providing prepaid account services to consumers comprising the steps of:

assigning prepaid accounts to said consumers;
associating said prepaid accounts with wireless telephones;
communicating with a banking network regarding consumer replenishment transactions, wherein said communicating with said banking network step further comprises the steps of:

receiving transaction messages following individual replenishment transactions by said consumers, wherein said receiving transaction messages step further comprises:

verifying that permanent account numbers have been activated;
receiving a reconciliation message summarizing substantially all individual transactions that occurred during a certain period;
reconciling said individual transactions; and
sending a message indicating the disbursement of funds associated with said replenishment transactions;

communicating with a prepaid engine regarding said consumer replenishment transactions; and

sending a disbursement message to said banking network, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions.

31. (Previously Presented) A method of providing prepaid account services to consumers comprising the steps of:

assigning prepaid accounts to said consumers;

associating said prepaid accounts with wireless telephones;

communicating with a banking network regarding consumer replenishment transactions, wherein said communicating with said banking network step further comprises the steps of:

receiving transaction messages following individual replenishment transactions by said consumers, wherein said receiving transaction messages step further comprises:

verifying that transaction identifiers associated with received transaction messages are not duplicates;

receiving a reconciliation message summarizing substantially all individual transactions that occurred during a certain period;

reconciling said individual transactions; and

sending a message indicating the disbursement of funds associated with said replenishment transactions;

communicating with a prepaid engine regarding said consumer replenishment transactions; and

sending a disbursement message to said banking network, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions.

32. (Previously Presented) A method of providing prepaid account services to consumers comprising the steps of:

assigning prepaid accounts to said consumers;
associating said prepaid accounts with wireless telephones;
communicating with a banking network regarding consumer replenishment transactions, wherein said communicating with said banking network step further comprises the steps of:

receiving transaction messages following individual replenishment transactions by said consumers, wherein said receiving transaction messages step further comprises:

identifying transaction messages that are in variance with information contained in said reconciliation message; and

logging said identified transaction messages in an exception file;
receiving a reconciliation message summarizing substantially all individual transactions that occurred during a certain period;

reconciling said individual transactions; and
sending a message indicating the disbursement of funds associated with said replenishment transactions;

communicating with a prepaid engine regarding said consumer replenishment transactions; and

sending a disbursement message to said banking network, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions.

33. (Canceled)

34. (Previously Presented) A system for replenishing prepaid accounts wherein real-time data is received from a bank, said real-time data comprising information related to a replenishment transaction and said data identifying a prepaid account, wherein the system comprises:

means for sending a message to a prepaid engine from a replenishment system, wherein said update message comprises information regarding an amount of money to be added to said prepaid account;

means for receiving summary data from said bank, wherein said summary data comprises information related to a plurality of said replenishment transactions;

means for reconciling individual replenishment transactions by comparing said real time data with said summary data; and

means for sending a disbursement message to said bank, wherein said disbursement message comprises information regarding the distribution of funds associated with said replenishment transactions.

35. (Previously Presented) The system of claim 34 wherein said bank is a banking institution.

36. (Previously Presented) The system of claim 34 wherein said bank is an entity that supports financial transactions over a point of sale network.

37. (Previously Presented) The system of claim 34 further comprising:

means for verifying location identification information associated with real time data from said bank, wherein said location identification information identifies authorized replenishment locations.

38. (Previously Presented) The system of claim 34 further comprising:

means for verifying that permanent account numbers have been activated.

39. (Previously Presented) The system of claim 34 further comprising:

means for verifying that transaction identifiers associated with real time data from said bank are not duplicates.

40. (Previously Presented) The system of claim 34 further comprising:
means for identifying replenishment transactions that are in variance with information
contained in said summary data; and
means for logging replenishment transactions identified by said means for identifying
into an exception file.